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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,081	07/10/2001	Richard E. Demaray	10655.0014-00	1225

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
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EXAMINER

HOFFMANN, JOHN M

ART UNIT	PAPER NUMBER
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1791

MAIL DATE	DELIVERY MODE
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01/29/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<div style="border: 1px solid black; width: 150px; height: 20px; margin: 0 auto;"></div> Office Action Summary	Application No. 09/903,081	Applicant(s) DEMARAY ET AL.	
	Examiner John Hoffmann	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-20, 24-27 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-20, 24-27 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement filed 12/05/2007 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

The IDS does not comply because it does not contain a list of the information submitted. Although a list was submitted, it was not a true list of the information provided. As indicated on the 1449 form that applicant needs to include the page (numbers). For example, the first listed item on the 1449 form refers to the Office Action in 11/100,856 - there is no indication of the pages. This is not trivial. The Office's eDAN system reflects that Applicant submitted 17 pages – but that the Office action is actually 16 pages. Thus such discrepancies could create a problem in the record. Thus the list/record is incomplete without the pages ^{being} indicated on the list.
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Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is confusing antecedent basis for "at least one of the plurality" in claims 16 and 19. They depend from claims which refer to "at least one". It is unclear if they are the same "at least one."

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nourshargh 4619680 in view of Liu 6117345 and Bazylenko 6154582.

See the prior Office actions for the manner in which the references were applied. The only meaningful change in scope is that the claims now recite a plurality of structures – wherein each structure has sidewalls; previously there need only be one sidewall portion. Nourshargh Figure 2 (a) has only one sidewall on each structure. However, the Nourshargh written description provides for a plurality of waveguides (e.g. see col. 1, lines 57-61.) Although not disclosed, one would immediately realize that when the stripes are made, that those areas between any two adjacent stripes would be one of the structures, with both walls thereof covered.

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Claims 15-17, 24-26 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nourshargh 4619680 in view of Liu 6117345 and Bazylenko 6154582 as applied to claim 14 above, and further in view of Klein 3850604.

See the prior Office actions for the manner in which the references were applied.

Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nourshargh 4619680 in view of Liu 6117345, Bazylenko, Klein 3850604 and Kestigian 4915810.

See the prior Office actions for the manner in which the references were applied.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nourshargh 4619680 in view of Liu 6117345 and Bazylenko 6154582 as applied to claim 14 above, and further in view of Makikawa 6615614.

See the prior Office actions for the manner in which the references were applied.

Response to Arguments

Applicant's arguments filed 12/5/07 have been fully considered but they are not persuasive.

It is argued that Examiner did not consider any of the documents listed in the 8/9/2007IDS. This is incorrect. For example, the very first listed document was considered. See the Office action mailed 18 December 2006. Examiner has considered all of the all those items which are in compliance with all statutes, rules and

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Official policies. As far as Examiner can tell Examiner has treated all IDS's properly. If Applicant has knowledge of any specific reference(s) that Examiner has treated improperly, Applicant ought to specify the reference by a complete citation of the reference, when it was submitted in a proper IDS, and where exactly in that IDS (by page and line number) list it is mentioned and any/all reason as to why it was improperly treated. The Office's record reflect 327 prior art items. The Office will NOT try to show all were properly treated. Rather, applicant has made repeated assertions of incorrect treatment of IDS's - none appear to ever have been true. Applicant is reminded that Applicant has a responsibility of compact prosecution - thus applicant has a responsibility to be more specific in pointing out any asserted errors.

Applicant's request to place the non-considered references into the file is granted. The Office places all submitted items into the record – irrespective of any errors in the items..

The Office has made various findings regarding the broadest reasonable interpretations of the claims. Applicant argued that these findings are inconsistent with the specification, drawings and the claims themselves, and not consistent with standard examining procedure. There is no indication as to what the inconsistencies are. As far as Examiner can tell, there is no indication of any specific error in the Office's findings, nor was there any assertion as to what the broadest reasonable interpretations should be. Although the arguments refer to how the claimed features are described in specific embodiments, Examiner does not see how such relates to the Offices findings. As pointed out by applicant: "...Fig. 4A is directed to an embodiment provided for

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illustrative purposes, and not necessarily the claimed embodiment. Thus the specifications discussion related to the embodiments are not necessarily what the claims are directed to. That is: Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

It is also argued that Nourshargh's figure 2)c) clearly shows that "the entire surface" of vertical surface is not completely and continuously covered. This does not appear to be very relevant because the Office made a finding as to what the broadest reasonable interpretation is, and since applicant has not made any specific assertions regarding any specific finding, Applicant should be reasonably entitled to utilize the Office's broadest reasonable interpretation in any future legal proceedings regarding this application. Thus it would be unfair for Examiner to now make another finding that the claim language is actually more narrow than previously indicated - absent a showing of an error in the finding. Thus based on that broadest reasonable interpretation, covered area is "an entire surface of the sidewalls".

Moreover, examiner finds that the claims (when interpreted in light of the specification) indicate require the broadest reasonable interpretation - it is the ONLY reasonable interpretation. Examiner first notes, that a claim interpretation that puts the preferred embodiment outside the claim is "rarely, if ever, correct and would require a highly persuasive evidentiary support", Vitronics, at 1583. Secondly, claim 20 requires a "core portion". Third, this "core portion" is only mentioned in the specification at page

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14, line 1 – which along with the last line of page 13 indicates there is “complete separation”. Thus, since applicant’s sole embodiment/disclosure related to a “core portion” has “complete separation” it is not reasonable to interpret a “core portion” claim as precluding “complete separation”. Thus absent “highly persuasive evidentiary support”, the Office must interpret the claims in a manner that reads on the embodiment which has “core portion” – and that embodiment has a complete separation.

Although Applicants note that Figure 4A is not necessarily the claimed embodiment, this does not appear to very relevant. The Office’s position is NOT that the claims are limited to any embodiment, rather that the claims have a sufficiently broad scope that encompass the lighthouse structure.

As to the arguments that Liu, Klein, Kestigian, Makikawa and Bazylenko does not teach the limitation regarding those entire surfaces being covered. This is not very relevant, because the rejection does not utilize a position for the rejection.

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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See the prior Office actions for the manner in which the references were applied.

Response to Arguments

Applicant's arguments filed 9 August 07 have been fully considered but they are not persuasive.

As to the IDS – applicant's arguments are no different from before. They are not convincing for the reasons previously given. It is noted that applicant has not clearly pointed out any error in the Office's finding that the IDS was improper. Examiner construes this as acquiescence that the Office's finding is proper.

It is argued that [0023] and [0038] provide support for the limitation that the core layer completely and continuously covers the entire surface of the ridge portion, the sidewall portion and the planar portion. Examiner disagrees. The specification does

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not teach anything about the planar portion of the ridge structure. The horizontal surface between the ridge structure is not a planar portion of the ridge structure.

It is also argued that figure 1c shows that "the entire surface" is covered. Examiner nothing in figure 1c that is disclosed to be "the entire surface".

As to the prior art it is argued that the claimed ridge portion does not refer to any ridge portions, but rather "the" ridge portion of the claimed ridge structure. That the portions are "clearly defined" in the specification and figures. Examiner could find nothing to support these arguments. At most the figures and specification describe an embodiment which portions and a ridge structure that are different from those in the prior art. But the claimed terms are not limited to the specific embodiments. Rather the terms are given their broadest reasonable interpretation. Applicant has not met the standard for being their own lexicographer.

The specification must clearly set forth the definition explicitly and with reasonable clarity, deliberateness and precision. *Teleflex Inc. v. Ficosa North America Corp.*, 63 USPQ2d 1374, 1381 (fed. Cir. 2002), *Rexnord Corp. v. Laitram Corp.* 60 USPQ2d 1851, 1854 (fed. Cir. 2001) and MPEP 2111.01.

There is a heavy presumption that a claim term carries its ordinary meaning which is not rebutted by simply point to embodiments of the invention disclosed in the specification. *CCS Fitness Inc. v. Brunswick Corp.*, 288 F.3d 1359, 62 USPQ2d 1658 (Fed. Cir. 2002). Applicant is "simply pointing" to embodiments of the portions and structure – this does not rebut the Office's showing that the claims portions can be any portion as indicated in the rejections.

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Regarding Nourshargh it is argued that the entire surface “of vertical surface” (sic) is not completely and continuously covered. This does not appear to be very relevant – for at least the reason the claims do not make any requirements on a vertical surface or its entire surface. Also, the phrase “of vertical surface” is used twice – so it is unclear whether such is a typographical error.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00-3:30.

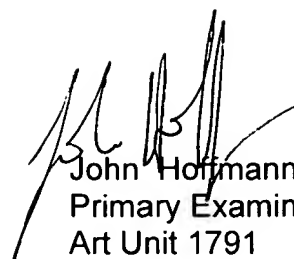
If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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John Hoffmann
Primary Examiner
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1/24/

jmh